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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,379	11/05/2001	Garrick Maenle	CYM-037	4705
23639	7590	06/14/2005	EXAMINER	
BINGHAM, MCCUTCHEN LLP THREE EMBARCADERO CENTER 18 FLOOR SAN FRANCISCO, CA 94111-4067			FINEMAN, LEE A	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/008,379

Applicant(s)

MAENLE ET AL.

Examiner

Lee Fineman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 March 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 79-101 is/are pending in the application.
- 4a) Of the above claim(s) 79-96 and 98 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 97 and 99-101 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 May 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                                                      |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                          | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                                 | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>see cont. sheet</u> . | 6) <input type="checkbox"/> Other: _____                                                |

Information Disclosure Statements(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 6/30/02, 8/12/02, 12/23/02 and 4/28/03

## **DETAILED ACTION**

### ***Inventorship***

1. In view of the papers filed 6 April 2005, it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48(a). The inventorship of this application has been changed by adding David Zahniser as an inventor.

### ***Election/Restrictions***

2. Applicant's election of Group V in the reply filed on 24 March 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 79-96 and 98 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

### ***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: all reference numbers for figs. 33-36. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the

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application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### *Specification*

4. The amendment (drawings) filed 28 May 2002 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Figs. 33-36, which were not part of the original submitted drawings nor mentioned in the original specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

5. The disclosure is objected to because of the following informalities: In the Brief Description of Drawings section, page 12, line 14, "FIG. 2" should add --including FIGS. 2A and 2B—and there is no description for figs. 33-36. Appropriate correction is required.

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6. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 97, 99 and 101 are rejected under 35 U.S.C. 102(b) as being anticipated by Luck et al. US 5,257,182.

Regarding claim 97, Luck et al. disclose an automatic focusing method for an optical system (12) comprising the step of determining an efficient order of presentation of fields of interest (fig. 4) on a slide (16) using an algorithm (column 3, line 55-column 4, line 39).

Regarding claims 99 and 101, Luck et al. further disclose an automatic focusing method for an optical system comprising the steps of: (a) performing an initial coarse focus (35, column 7, lines 5-6) at a first position (first block 60) substantially corresponding to a first point on a surface substantially corresponding to the surface of a slide (column 7, lines 1-10); and (b) subsequently performing a plurality of subsequent fine focuses (35 and column 7, lines 39-42 or 40 and column 14, lines 13-18) at different positions (64), wherein each of the fine focuses are performed more quickly than the initial coarse focus (column 4, lines 6-11); and wherein the fine

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focuses of step (b) are each performed by imaging a position (64) substantially corresponding to a point on the surface of the slide no more than five times (only 2 times, scans 35 and 40).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 100 is rejected under 35 U.S.C. 103(a) as being unpatentable over Luck et al. in view of Fujihara et al. US 4,902,101.

Luck et al. does not explicitly state that the steps of the initial coarse focus being (I) imaging the slide at the first position; (II) determining a focus score at the first position; (III) subsequently moving an element of the optical system relative to the surface of the slide by a first amount to a second position; (IV) subsequently imaging the slide at the second position; (V) determining a focus score at the second position; (VI) moving an element of the optical system relative to the surface of the slide by a second amount that is less than the first amount. Fujihara et al. discloses a automatic focusing method for a microscope that includes the steps of (I) imaging the slide at the first position (HP); (II) determining a focus score at the first position (contrast value); (III) subsequently moving an element (objective lens) of the optical system relative to the surface of the slide by a first amount (D) to a second position (column 4, lines 15-23); (IV) subsequently imaging the slide at the second position (column 3, lines 42-53); (V) determining a focus score at the second position (second contrast value Ca-n); (VI) moving an

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element of the optical system (objective lens) relative to the surface of the slide by a second amount that is less than the first amount (column 4, lines 48-50). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the initial coarse focus of Luck et al. include the focusing steps of Fujihara et al. to further reduce focusing time (Fujihara et al., column 2, lines 50-51).

### *Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Douglass et al., US 6,215,892 discloses an automatic focusing method.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee Fineman whose telephone number is (571) 272-2313. The examiner can normally be reached on Monday - Friday 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



LAF

June 7, 2005



MARK A. ROBINSON  
PRIMARY EXAMINER